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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/457,049 | 12/07/1999 | SHMUEL SHAFFER | 99P7399US | 7243 |

7590 05/08/2002

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EXAMINER

NGUYEN, QUYNH H

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/457,049

Applicant(s)

SHAFFER ET AL.

Examiner

Quynh H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 9-11, and 16- 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Brennan et al. (U.S. Patent 5,329,578).

Referring to claim 1, Brennan et al. teach a method for enabling a caller to locate a called party using a computer system comprising: providing a contact list manager (Table 4.0) in which a called party (subscriber) can stored a list of two or more contacts (entries in Table 4.0); and upon receiving a request to locate a called party, referring to said contact list to automatically attempt to locate said called party (col. 7, lines 26-30).

Referring to claim 2, Brennan et al. teaches contact list manager comprises: one or more contact methods (col. 7, lines 50-55) for each contact; and one or more rules (col. 7, lines 47-50) applicable to contacts and contact methods regarding when or how to send a locator request (col. 7, lines 47-55).

Referring to claim 3, Brennan et al. teaches one or more contact methods is one or more methods selected from the group (Table 5.0) consisting of: one or more telephone numbers (Table 5.0, Personal Number).

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Referring to claim 4, Brennan et al. teaches contact list database stores additional contact information designating the conditions for usage (Table 4.0 and col. 7, lines 47-60) of said contacts or said contact methods.

Referring to claim 9, Brennan et al. discloses a called party is identified and identities of called parties (Table 4.0, Day and Time) are used in part to determine system behavior (Table 4.0, Treatment and Urgency).

Referring to claim 10, Brennan et al. discloses called party may configure system behavior for a calling party (col. 4, line 67 thru col. 5, line 2 and Table 1.0).

Referring to claim 11, Brennan et al. discloses messages are predetermined prior to receiving said request (col. 10, lines 37-48).

Referring to claim 16, Brennan et al. discloses an apparatus for automatically locating a called party comprising: a contact list manager (Table 4.0) in which a called party can store a list of two or more contacts (entries in Table 4.0); and a configuration interface – means to accept input into a messaging system (col. 11, lines 13- 23); a locator (col. 10, lines 34-48) capable of sending out location request messages and receiving and handling responses.

Referring to claim 17, Brennan et al. discloses one or more contact lists (Table 5.0) associated with one or more called parties; and one or more rule sets (col. 7, lines 47-50) associated with one or more called parties.

Referring to claim 18, Brennan et al. discloses one or more system or group contact lists (Table 2.0, other devices) providing contacts that are applicable to more than one called party; and one or more system or group rule sets (Table 4.0, entries under Day & Time) applicable to more than one called party.

Referring to claim 19, Brennan et al. discloses and interface for receiving one or more responses (col. 10, lines 34-43) to location requests; and an presentation module (col. 13, line 68 thru col. 14, line 3) for presenting responses to a caller.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 5, 6, 8, 12-15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et al. (U.S. Patent 5,329,578).

Referring to claim 5, Brennan et al. teaches automatic attempting to locate said called party comprises: automatically sending one or more messages (Table 4.0, treatment and col. 7, lines 58-60) to parties listed in a contact list requesting location information (Table 4.0, day, time, treatment) regarding said called party. Receiving responses to said one or more messages and presenting a response to a calling party (col.13, line 63 thru col. 14, line 5); but Brennan et

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al. fail to teach canceling outstanding messages when a response is received. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel outstanding contact messages once the party of interest has been located.

Referring to claim 6, Brennan et al. disclose a method for a locating a called party comprising: receiving a request to locate a called party (col. 13, lines 58-61); and automatically sending one or more messages (Table 4.0, treatment and col. 7, lines 58-60) to parties listed in a contact list requesting location information (Table 4.0, day, time, treatment) regarding said called party.

Referring to claim 8, Brennan et al. teach receiving responses to said one or more messages and presenting a response to a calling party (col. 13, line 63 thru col. 14, line 5); but Brennan et al. fail to teach canceling outstanding messages when a response is received. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel outstanding contact messages once the party of interest has been located.

Referring to claim 12, Brennan et al. as discussed above, Brennan et al. further teach the prompt play back unit and these prompts are usually the ones provide by the service provider with information regarding the called party (col. 10, lines 34-43), but Brennan et al. fail to teach the parties on the contact list may submit responses to said messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to let the parties on the contact list submit responses to said messages.

Referring to claim 13, Brennan et al. discloses the calling party is automatically notified of said responses (col. 10, lines 34-37). Responses contain a contact method for reaching the called party (col. 6, lines 42-45). But Brennan et al. fail to teach the called party may cancel the

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called party location process at any time including automatically canceling, expiring and/or recalling all dispatched messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel outstanding contact messages once the party of interest has been located.

Referring to claims 14 and 15, Brennan et al. as discussed above, but Brennan et al. fail to teach messages may be automatically cancelled expired or recalled based on a timer or based on the successful establishment of a contact between calling and called parties. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel expired or recalled messages based on a timer or successful establishment of a contact between calling and called parties once the party of interest has been located.

Referring to claim 20, Brennan et al. as discussed above, but Brennan et al. fail to teach a cancellation module for determining when to cancel outstanding messages and sending cancellation requests. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have outstanding locator requests cancelled at various steps in the process.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et al. (U.S. Patent 5,329,578) in view of Will (U.S. Patent 5,905,789).

Referring to claim 7, Brennan et al. as discussed above, but Brennan et al. fail to teach allowing a called party to configure contact list, Will teaches called party can configure contact list (col. 4, lines 54-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to let user create/configure contact list.

6. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

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or faxed to:

(703) 308-6306, (for formal communications intended for entry, please label the response "EXPEDITED PROCEDURE")

or: (703) 308-6296, (for informal or draft communication, please label "PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Friday from 7:00 A.M. to 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn
Quynh H. Nguyen
May 6, 2002


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600